

Appl. No. 10/614,500  
Amdt. dated 04/12/2005  
Reply to Office action of 01/11/2005

### **REMARKS / ARGUMENTS**

For the convenience of the Examiner and clarity of purpose, Applicant has reprinted the substance of the Office Action in *10-point bolded and italicized font*. Applicant's arguments immediately follow in regular font.

*Claims 1,2,6-16,18-23,25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Finley 5,676,208. Finley discloses a method and apparatus for controlling flow through a return port 134. Sleeve 126 has engagement means 152 thereon to shift the sleeve from the position blocking ports 134 to a position where the return ports are open. A shifting tool (not shown) has engagement surfaces for engaging profile 152. The shifting tool is considered a downhole member disposed in the well. (See col. 10, lines 11-25). Once the shifting tool is disengaged, the sleeve returns to the first position.*

Applicant respectfully disagrees with the Examiner's characterization of what Finley discloses and teaches, and its application to the claimed subject matter. Generally, Finley discloses a type of pressure safety valve to relieve pressure on a production screen during gravel packing operations. As such, Finley's device is disclosed to control or affect flow between an annulus 72 formed below a packer 12 (i.e., outside of the screen) and a circulation path 70 to the surface (i.e., the inside of a cross-over tool). The sleeve or differential pressure valve of Finley is disclosed to be primarily operable by a differential pressure and secondarily, in some limited embodiments, by a mechanical shifting tool.

The Examiner's characterization of Finley that "once the shifting tool is disengaged, the sleeve returns to the first position" is not understood. Applicant does not read Finley to disclose or teach that the sleeve 126 is biased to return to the first or closed position. Finley discloses that a shifting tool may engage profile 152 to open or close the sleeve 126 (column 10, lines 12-24),

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but Applicant finds no disclosure or teaching that the sleeve 126 is biased to return to the closed position. Indeed, Finley specifically notes that “the apparatus 80 and 120 also do not rely solely on differential pressure for activation thereof, *and do not reciprocate between open and closed positions.*” See column 10, lines 48-51 (emphasis added).

In contrast, claim 1 is directed to a method of affecting flow through a return port in a well treatment tool. To more clearly point out what Applicant regards as the invention, claim 1 has been amended to recite that the “downhole member” separates an annulus into an upper annulus and a lower annulus, and to recite that the “return port” is associated with the “well treatment tool.” Thus, with this amendment, the shifting tool used by Finley cannot be properly considered a “downhole member” because it does not separate an annulus, as required by amended claim 1. Further, because Finley is predominately a pressure actuated device, there is no combination of “engagement surfaces” on a tool having a return port and return port cover, and the downhole member. Finley cannot anticipate amended claim 1. Reconsideration is respectfully requested.

Claim 12 is directed to a “well treatment tool” having a return port and cover. The return port cover is recited to have an “engagement surface” that is adapted to engage another surface disposed downhole. Figure 4 of Finley and related text is the only arguable disclosure of a return port (ports 226) and return port cover (valve portion 204) in a well treatment tool (service tool string 188). Finley discloses that the valve portion is actuated by differential pressure (column 13, lines 1-16). Finley contains no disclosure or teaching that the valve portion 204 is

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movable by engagement with a downhole member – only by differential pressure. Finley cannot anticipate original claim 12. Reconsideration is respectfully requested.

*As to claims 2, 15 and 21, the tool includes a crossover 52. As to claim 6, the first position is a closed position and the second an open position.*

For at least the reasons stated above with respect to claim 1, claims 2 and 6 are not anticipated.

For at least the reasons stated above with respect to claim 12, claim 15 is not anticipated.

For at least the reasons stated above with respect to claim 20, claim 21 is not anticipated.

*As to claims 7 and 22, spring means biases the sleeve 126 from the second open position to the first closed position.*

Applicant disagrees with the Examiner's characterization of Finley as disclosing a "spring means" that biases the sleeve 126. The only occurrence of "spring" or "bias" that was found in Finley is when he describes the prior art Smyrl et al. reference. See column 2, lines 29-32. Further, Finley criticizes the Smyrl device because this spring allows the Smyrl device to reciprocate between an open and a closed position. See column 2, lines 52-57. Finley does not disclose the use of a spring to bias the sleeve 126. Neither claim 7 nor claim 22 has been amended in response to this rejection. Reconsideration is respectfully requested.

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*As to claim 8, the shifting tool can be run in with the entire assembly and released after operating the sleeve. As to claim 9, the tool is used in fracturing or gravel packing. As to claim 10, a spring biases the sleeve to the return position. As to claim 11, the sleeve 126 is carried on the wall of the tool having the return ports 134. Engagement surfaces 152 engage surfaces on the shifting tool that are independent from the tool.*

Claims 8 through 11 are allowable for at least the reasons recited above with respect to claim 1. None of claim 8 through 11 has been amended in response to this rejection. Reconsideration is requested.

*As to claim 13, the first position is used during circulation. As to claim 14, the second position is used during reversing position. As to claim 16, shifting tool is a downhole member. As to claim 18, the shifting tool operates the valve independent of downhole conditions that induce tubing movement. As to claim 19, the entire assembly is run on a work string and the tool string is attached to the work string.*

Claims 13 through 19 are allowable for at least the reasons recited above with respect to claim 12. None of claim 13 through 19 has been amended in response to this rejection. Reconsideration is requested.

*As to claim 20, sleeve 126 can be operated at any selected time.*

Claim 20 has been amended to recite that the "return port" facilitates "communication between an upper annulus and a lower annulus" and that the "means for at least partially opening and closing" is independent of a well treatment pressure. The devices disclosed and taught by Finley are operatable by a pressure differential. Finley cannot anticipate claim 20 as amended. Reconsideration is respectfully requested.

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*As to claim 23, profile 152 engages a profile on the shifting tool. As to claim 25, the shifting tool is raised and lowered to operate the sleeve. As to claim 26, the shifting tool carries an engagement surface.*

Claims 23 through 26 are allowable for at least the reasons recited above with respect to claim 20. None of claim 23 through 26 has been amended in response to this rejection. Reconsideration is requested.

*Claim 14 is objected to because of the following informalities: In line 2, "revering" should be —reversing—. Appropriate correction is required.*

Claim 14 has been amended by deleting the typographical error "revering" and replacing it with the clearly intended "reversing. Reconsideration is requested.

*Claims 3-5,17 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.*

Applicant thanks the Examiner for his consideration of these claims. At the present time, Applicant elects not to rewrite these claims in favor of the arguments and amendments presented above.

#### **Other Amendments to the Claims**

Any amendment made to a claim that is not discussed above in direct response to a rejection or objection, such as the amendment made to claim 19, was not made for reasons related to patentability.

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**New Claims**

Applicant has presented new claims 27 – 30. Independent claim 27 is drawn to a well treatment tool and, for many of the reasons discussed above with respect to the original and amended claims, this claim, and its dependents, are thought to be allowable.

**Conclusion**

Applicant hereby petitions for a one month extension of time in which to file this response. An additional fee for the presentation of the new claims is also believed due. Authorization is hereby given to charge the undersigned's deposit account, 12-1322 (020569-02500), for the extension fee and for the new claims fee, and for any other fee that may be necessary to make this a timely and effective amendment.

Applicant thanks the Examiner for his consideration and effort on this matter and submits that this application is now in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

  
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